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EXAMINER

MELLER, MICHAEL V

ART UNIT PAPER NUMBER

1655

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/072,823

Filing Date: February 08, 2002

Appellant(s): CHEN, SOPHIE

Karen LeCuyer
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed 11/4/2005 appealing from the Office action mailed 7/28/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

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The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. It is noted that appellant stated that this was the "Summary of the Invention" but there is no substantial difference between this and the heading of "Summary of the claimed subject matter" and all of the claims and points in the specification are referenced. Thus, the heading is proper.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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| | | |
|--------------|-----------------------|---------|
| JP 52145509 | Matsui T. | 12-1977 |
| JP 352102434 | Fujita et al. | 8-1977 |
| JP 57167938 | Taiho Pharm. Co. Ltd. | 10-1982 |
| UK 1476016 | Fujita et al. | 6-1977 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11-16, 18-23, 26-29, 32-35 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57167938 (JP '938), GB 1476016 (GB) or JP 352102434 (JP '434) taken with JP 11236334 (JP '334) or JP 52145509 (JP '509).

JP '938, JP '434 and GB teach oridonin used to treat cancer.

JP '334 or 509 teach extracts from *Humulus lupulus* which are used for treating cancer. Lupulone is very well known in the art to be in extracts of *Humulus lupulus* (hops) as readily admitted by appellant at bottom of page 2 of their own specification and they even supplied a well known reference to show this. Accordingly, lupulone would inherently be contained within such extracts.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining

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them flows logically from their having been used individually in the prior art. *In re Sussman*, 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Thus, since each component is known individually in the prior art for the same purpose, i.e. to treat cancer, then it would have been obvious to combine the two components into one formulation.

(10) Response to Argument

Appellants first argue that JP '334 does not teach the type of cancers that it treats. Fact is, JP'334 treats cancer as do all the other references, thus it would have been obvious to put the two components together. Appellant is trying to change the topic at hand which is the motivation to combine oridonin and lupulone into one composition. Since the clearly show that individually in the prior art of record lupulone and oridonin are used to treat cancer then it would have been obvious to one of ordinary skill in the art to combine lupulone and oridonin together to make a third composition to treat cancer. All that is required is that the components individually in the art are known to be used for the same purpose, which they are.

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Appellants next argue that the references teach different types of cancer treated in each reference and therefore they are not properly combinable. Fact is, the references each teach anti-cancer treatment and never specify what type of cancer that they are treating. The claims are to a composition not to a method of treating a specific type of cancer. All that is required is that there is a clear motivation to combine the two ingredients together (lupulone and oridonin) to create a third composition which has the same purpose as the two ingredients, which is true.

Appellants next argue that JP '509 cannot contain the claimed lupulone since appellants argue that lupulone allegedly cannot be extracted with water. There were no arguments on the record to ever reflect this fact and no such evidence has been offered by appellant. Appellant had the burden of supplying this alleged evidence which was never presented by them, thus the statements are without merit.

Appellants provided a reference by Todd Golub saying that new drug combinations for cancer treatments are very successful and that the older ones have been unsuccessful in the past. While this is what the reference might be saying, the author was not referring to appellant's invention. Mr. Golub was referring to some other combination and not appellant's claimed combination. Thus, the article really does not add anything at all.

Appellants next argue that the extracts from the plants in the references are not plant extracts and this is simply not agreed with. Anytime a plant is squeezed, ground, etc. a plant extract results by definition. Thus, the references do in fact, teach plants extracts.

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Appellant next continues to argue case law. The case law is simple. If you have two components individually used in the art for the same purpose and a composition of the two is being claimed then it would have been *prima facie* obvious to combine them into one composition. The motivation being that two or more components are already known in the art individually for the same purpose (as an anti-cancer agent) and it would then follow that combining the two components can only enhance their desired effect.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
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MVM

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